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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.
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INVENTOR'S FULL NAME AND ADDRESS

100

EDWARD W. THOMAS
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WASHINGTON, D.C. 20037

and

EXAMINER

MAILING NO. 1

ART UNIT	PAPER NUMBER
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100

12

DATE MAILED:

11/15/99

Please find below and/or attached an Office communication concerning this application or proceeding.

Commissioner of Patents and Trademarks

Docketed
11/15/99

Seal

Office Action Summary

Application No.
09/016,641

Applicant(s)

Gately

Examiner

Jean F. Vollano

Group Art Unit

1621



☒ Responsive to communication(s) filed on Sep 23, 1999

☒ This action is **FINAL**.

See P 4 P, 6

☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11; 453 O.G. 213.

A shortened statutory period for response to this action is set to expire 3 month(s), or thirty days, whichever is longer, from the mailing date of this communication. Failure to respond within the period for response will cause the application to become abandoned. (35 U.S.C. § 133). Extensions of time may be obtained under the provisions of 37 CFR 1.136(a).

Disposition of Claims

☒ Claim(s) 1-8, 10-12, and 14-16 is/are pending in the application.

Of the above, claim(s) 1-8, 14, and 15 is/are withdrawn from consideration.

☐ Claim(s) _____ is/are allowed.

☒ Claim(s) 10-12 and 16 is/are rejected.

☐ Claim(s) _____ is/are objected to.

☐ Claims _____ are subject to restriction or election requirement.

Application Papers

☐ See the attached Notice of Draftsperson's Patent Drawing Review, PTO-948.

☐ The drawing(s) filed on _____ is/are objected to by the Examiner.

☐ The proposed drawing correction, filed on _____ is ☐ approved ☐ disapproved.

☐ The specification is objected to by the Examiner.

☐ The oath or declaration is objected to by the Examiner.

Priority under 35 U.S.C. § 119

☐ Acknowledgement is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d).

☐ All ☐ Some* ☐ None of the CERTIFIED copies of the priority documents have been received.

☐ received in Application No. (Series Code/Serial Number) _____

☐ received in this national stage application from the International Bureau (PCT Rule 17.2(a)).

*Certified copies not received: _____

☐ Acknowledgement is made of a claim for domestic priority under 35 U.S.C. § 119(e).

Attachment(s)

☐ Notice of References Cited, PTO-892

☐ Information Disclosure Statement(s), PTO-1449, Paper No(s). _____

☐ Interview Summary, PTO-413

☐ Notice of Draftsperson's Patent Drawing Review, PTO-948

☐ Notice of Informal Patent Application, PTO-152

--- SEE OFFICE ACTION ON THE FOLLOWING PAGES ---

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DETAILED ACTION

1. The petition for review of the restriction, filed 5/28/99, has been entered. The petition has been denied. The amendment filed 9/23/99, paper no 11, has been entered. Claims 9 and 13 have been canceled. Claims 1-8, 10-12, 14-15 and newly added claim 16 are pending. Claims 1-8, and 14-15 are withdrawn from consideration as being drawn to a non elected invention.
2. Applicant states that the cancellation of claim 9 makes the 35 U.S.C. 112, paragraph 2 moot. This is correct.
3. The rejection of claims 9-12 under 35 U.S.C. 103(a) as being unpatentable over Winter et al (US5576260) in view of Chem abs128 (CA: 116:21128) and Applicant's admission is withdrawn.
4. The rejection of claims 16, and 10-12 under 35 U.S.C. 103(a) as being unpatentable over Palackal et al (US5401817) in view of Chem abs128 (CA: 116:21128) and Applicant's admission is maintained for reasons of record found in the office action of 3/25/99, paper no 7. The examiner notes that since there is no representation of "formula II" present in the claims, the claims read on any organometallic or organosilicon compound. Applicant's statement that the amendment has removed the silylene ester discussed in the primary reference would be correct if

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there was a drawing of formula (II) in the claim to eliminate the ester and other groups from the claim.

Claim Rejections - 35 U.S.C. § 112

5. Claims 16 and 10-12 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

Newly added claim 16 recites the limitation of "reacting a -CH group with a compound having the formula RM". The phrase is unclear as to what is the -CH group's function and what the -CH group entails. The compound being made in this step of the process (by the reaction of RM and -CH) is called -CM. This would seem to be a reaction wherein there is a deprotonation of the carbon to form an anion with a lithium, sodium etc. counter ion such as in the formation of butyl lithium. R in the formula RM is defined as a hydrocarbon group. If R is the hydrocarbyl group butyl and M is lithium the one would have butyl lithium. This is indeed one of the preferred compounds for RM in the specification (page 6, second paragraph). Butane is a moiety with a C-H group in it. If one reacted butane (e.g. -CH) with butyl lithium one would have butyl lithium. Butyl lithium is also a moiety that has a -CH in it. How can one react butyl lithium with butyl lithium? Cyclopentadiene has a -CH and would react with RM. However cyclopentadiene is also one of the compounds useable in step ii that reacts with -CM. The phrase is unclear and indefinite as to the metes and bounds of what is being claimed.

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It is noted by the Examiner that all the relevant examples in the specification have butyl lithium (RM). However the butyl lithium is the reagent in the examples that reacts with the indene type ligands (i.e step ii). In the reaction in claims 10-12 and 16 it is the -CM which reacts with the indene or cyclopentadiene type ligand not the RM. Are these the same groups?

The formula in claim 16 has a pentagon drawn with something inside that looks like an equals sign. If they (i.e. the two lines) are suppose to be bonds they should begin at a carbon and end at a carbon and not be dropped in the middle of the ring. The claim is vague as to what compounds are encompassed in the drawing.

Claim 16 recites the limitation of reacting the metallocene ligand with a compound of Formula (II). However there is no formula II described in the claim which is the independent claim.

Claim 16 is written in a confusing manner and replete with problems.

Claim 11 which depends on claim 16 recites "formula II" however there is no formula II described in claim 16. The claim is vague and indefinite as to the metes and bound of what is being claimed.

6. Applicant's amendment necessitated the new ground(s) of rejection presented in this Office action. Accordingly, **THIS ACTION IS MADE FINAL**. See MPEP § 706.07(a). Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

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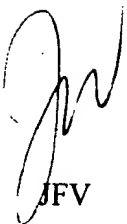
7. A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the date of this final action.
8. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Dr J F Vollano whose telephone number is (703) 305-4483. The examiner can normally be reached on Monday to Thursday from 6:30 to 5:00 .
9. If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Gary Geist , can be reached on (703)308-1701 . The official fax phone number for the organization where this application or proceeding is assigned is (703)308-4556. It should be noted that the examiner cannot immediately work on a fax sent to this number.

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10. Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is (703)308-1235.



GARY GEIST
SUPERVISORY PATENT EXAMINER
TECH CENTER 1600


JFV

November 6, 1999